

Attorney's Docket:

09-22-03
01/misc. Ltr AF
PATENT APPLICATION
USSN 09/594,652
3600
10-D2-03
L. Ellis



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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GROUP 3600

In re Application of: Shekhar Iyer, et al.
Serial No.: 09/594,652
Filing Date: June 15, 2000
Art Unit: 3623
Examiner: Eric T. Shaffer
Confirmation No.: 9277
Title: Product Substitution Search Method

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Commissioner for Patents
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Willie Jiles

Willie Jiles

Letter Regarding Incomplete Final Office Action

Applicants received an Advisory Action mailed September 10, 2003. The Advisory Action includes a Decision On Petition denying a Petition Under 37 C.F.R. § 1.37 for Consideration of an Information Disclosure Statement (IDS). The Examiner apparently interpreted Applicants' request in the Response to final Office Action for the Examiner to consider an IDS as such a Petition. Applicants respectfully submit that this is incorrect. Applicants respectfully submit that the final Office Action was incomplete because Applicants were entitled to have the IDS considered in the final Office Action. Accordingly, Applicants respectfully submit that the final Office Action must be withdrawn, the IDS considered, and a new Office Action issued after consideration of the IDS.

37 C.F.R. § 1.97(c) plainly states:

An information disclosure statement *shall be* considered by the Office if filed after the period specified in paragraph (b) [i.e. after mailing of

a first Office Action on the merits] of this section, provided that the information disclosure statement is filed before the date of any final action under § 1.113, a notice of allowance under § 1.311, or an action that otherwise closes prosecution in the application, and it is accompanied by one of:

- (1) The statement specified in paragraph (e) of this section; or
- (2) The fee set forth in § 1.17(p).

(emphasis added)¹

Applicants filed an IDS on May 22, 2003 (copy attached) before the date of the final Office Action. Receipt of this IDS is evidenced by the acknowledgment post card bearing a PTO date stamp of May 22, 2003 (copy attached). Furthermore, pursuant to 37 C.F.R. § 1.97(c), Applicants enclosed with the IDS a check for \$180.00 to cover the cost of filing the IDS after the date of the first Office Action but before the date of the final Office Action (copy of check stub attached). Receipt of the check is also evidenced by the acknowledgment post card. Thus, Applicants timely and properly filed the IDS, and 37 C.F.R. § 1.97(c) and M.P.E.P. § 609 plainly require that the Examiner consider the IDS.

In the final Office Action mailed June 6, 2003 (after Applicants filed the IDS), the Examiner did not indicate his consideration of the references listed on the IDS, which was properly filed prior to the date of the final Office Action. Applicants noted this in their Response to the final Office Action filed August 6, 2003 (copy of relevant page attached). Instead of issuing a new Office Action indicating consideration of the references in the IDS as required under 37 C.F.R. § 1.97(c), the Examiner issued the Advisory Action, improperly interpreting Applicants' request for consideration of the IDS as a Petition under 37 C.F.R. § 1.37.

Applicants recognize that the IDS may not have reached the desk of the Examiner as of the date the Examiner issued the final Office Action. Nevertheless, since the filing of the IDS predates the final Office Action and Applicants filed the IDS with the appropriate fee, Applicants are entitled to have the IDS considered on the merits in an Office Action under 37 C.F.R. § 1.97(c) and M.P.E.P. § 609.

¹ The M.P.E.P. provides, "Once the minimum requirements of 37 CFR 1.97 and 37 CFR 1.98 are met [which they were in this case], the examiner has an obligation to consider the information." M.P.E.P. § 609; *see also* M.P.E.P. § 609(III)(B)(2).

Accordingly, Applicants respectfully request that the Examiner (1) withdraw the final Office Action, (2) consider on the merits the art submitted with the IDS, and (3) issue a new Office Action which takes into account the art submitted with the IDS. Applicants also respectfully request that the shortened statutory period for a response be restarted on the date the new Office Action is mailed.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Applicants



Christopher W. Kennerly
Reg. No. 40,675

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Date: 9/17/03

Enclosures:

Copy of May 22, 2003 IDS
Copy of post card bearing PTO date stamp of May 22, 2003.
Copy of check stub mailed with the IDS
Copy of relevant page of Response to final Office Action

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Shekhar Iyer, et al.
Serial No.: 09/594,652
Date Filed: June 15, 2000
Art Unit: 3623
Examiner: E.T. Shaffer
Title: Product Substitution Search Method

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Willie Jiles
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Information Disclosure Statement

Applicants respectfully request, pursuant to 37 C.F.R. §§ 1.56, 1.97 and 1.98, that these references listed on the attached PTO-1449 form be considered and cited in the examination of the above-identified patent application. Copies of these references are enclosed for the convenience of the Examiner. No representation is made that a search has been made, that these references are material to the patentability of the present application, or that these references qualify as prior art.

This Information Disclosure Statement is being submitted pursuant to 37 C.F.R. § 1.97(c).

Applicants enclose a check for \$180 to cover the cost of filing this Information Disclosure Statement. The Commissioner is hereby authorized to charge any additional fee or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.

Christopher W. Kennerly

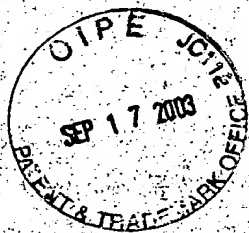
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Date: 5/22/03

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<input type="checkbox"/> Amendment/Response			

Name of Inventor(s): Shekhar Agrawal et al.

Receipt Date & Serial No:

Title of Invention: Product Substitution Search Method

Client or Applicant: i2 Technologies US

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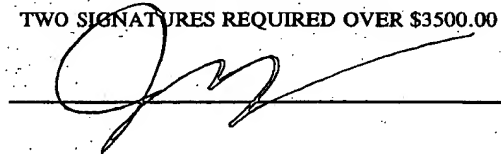
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Willie Jiles

Willie Jiles

Response Pursuant to 37 C.F.R. § 1.116

In response to the final Office Action mailed June 6, 2003, Applicants respectfully request the Examiner to reconsider the rejection of the claims in view of the following amendments and remarks. Please amend the Application as follows.

Information Disclosure Statement

An Information Disclosure Statement (IDS), accompanying PTO-1449 form, and references were submitted on May 22, 2003 but were not indicated as having been considered by the Examiner in the final Office Action. Applicants request the Examiner to indicate consideration of the IDS and references by initialing next to each reference on the PTO-1449 form. For the Examiner's convenience, copies of the IDS and PTO-1449 form are attached to this Response.

The Claims are Allowable over *Linden*

The Examiner rejects Claims 1-5 and 7-48 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,266,649 to Linden et al. ("*Linden*"). Applicants respectfully disagree.

Linden fails to disclose numerous limitations specifically recited in Applicants' independent claims, whether *Linden* is considered alone, in combination with any other reference of record, or in combination with knowledge generally available to those skilled in the art at the time of the invention. For example, at a minimum, *Linden* fails to disclose, teach, or suggest the following limitations specifically recited in independent Claim 1 (and substantially similar limitations specifically recited in independent Claims 5, 33, and 48):

- *the user request specifying a desired attribute value for each of one or more selected product attributes*
- *a search procedure operable to select a set of one or more candidate alternative products having attribute values consistent with the desired attribute values specified in the user request for the selected product attributes*
- *for each potential alternative product in a set of potential alternative products the search procedure operable to:*

for each selected product attribute, compare the desired attribute value specified in the user request with the attribute value for the potential alternative product to determine a attribute similarity value for the selected product attribute for the potential alternative product; and

determine a product similarity value for the potential alternative product according to the attribute similarity values, each attribute similarity value having been determined for a selected product attribute for which a desired attribute value is specified in the user request by comparing the